

Application Number: 09/694,176

Docket: 98-15DIV1

REMARKS

Claims 30-34 and 38-45 are presently pending in the above-referenced application. Applicants respectfully request further consideration of these claims, in view of the amendments set forth above and the following remarks.

Amendments to the Specification

The specification has been amended to update the reference to related applications, and to correct typographical errors.

No new matter is added.

Amendments to the Claims

Claim 30 has been amended to clarify that the material samples being screened are *metal* samples (e.g., different metal elements or alloys for use as anodic or cathodic materials, such as electrocatalysts.).

No new matter has been added.

New Claims

New claims 38-44 have been added to claim certain preferred embodiments of the invention. Support for these claims can be found throughout the specification, including for example at page 10, line 1 through page 11, line 22, and in Figures 4A through 4E.

No new matter has been added.

Acknowledgement

Applicants acknowledge that claims 32 through 34 are considered patentable and would be allowed if rewritten in independent form.

Rejections Under 35 U.S.C. § 102(e)

Claim 30 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Chow (U.S. Patent No. 5,955,028). See paragraphs 3 and 4 at pages 2-3 of the Office action. Claims 30 and

Application Number: 09/694,176

Docket: 98-15DIV1

31 have been rejected under 35 U.S.C. §102(e) as being anticipated by Yee (U.S. Patent No. 5,672,256). See paragraphs 5 and 6 at pages 3-4 of the Office action.

Applicants respectfully traverse these basis for rejection, in view of the aforementioned amendments and the following remarks.

Claim 30

Claim 30 is directed to a system for electrochemically screening an array of materials. The materials are different metals (e.g., different metal elements or alloys for use as anodic or cathodic materials, such as electrocatalysts). The metal materials are presented for screening as an array on a substrate that further comprises corresponding electrodes.

Chow

Chow does not teach a system for electrochemically screening that comprises an array of different metal materials. Rather, Chow teaches an analytical system for testing chemical and biological reaction systems and preparatory procedures. Chow teaches testing analytes by flowing fluids from reagent reservoirs (60, Fig. 1) through micromachined channels (66, Fig. 1) to a reaction chamber (50, Fig. 1). The electrodes (44, Fig. 1) are said to provide for effecting electrokinetic flow control of a fluid on the sample substrate, or to "energetically excite" a region on the substrate. See Col. 9, line 51 through Col. 10, line 14.

Therefore, claim 30 is novel over Chow.

Yee

Yee likewise does not teach a system for electrochemically screening that comprises an array of different metal materials. Yee teaches a multi-electrode biosensor system, in which electrodes have biomaterials (e.g., enzymes, antigens, antibodies, nucleic acids and molecular receptors) fixed thereon. See Col. 5, lines 57-62.

Therefore, claim 30 is novel over Lee. Since claim 31 depends from claim 30, it is likewise novel over Lee.

Application Number: 09/694,176

Docket: 98-15DIV1

Obviousness

Although not raised in the outstanding Office action, Applicants submit that the inventions defined by the presently-pending claims would not have been obvious over Chow, Lee or other art of record.

In particular, Applicants note that a person skilled in the art would not have modified either Chow or Lee, considered alone or in combination with each other and/or with other art of record, in a manner that would have led to Applicants invention, since such modification would have made the devices disclosed in Chow or Lee unsuitable for their intended purposes. It is well settled that no suggestion or motivation can be established for proposed modifications to a prior art embodiment, where such modifications would render the prior art embodiment unsuitable or unsatisfactory for its intended purpose. *See* MPEP 2143.02; *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, each of the pending claims is now in condition for allowance, and Applicants respectfully request notice of the same.

Inventorship

Applicants submit herewith a Petition to Correct Inventorship and the necessary fee pursuant to 37 C.F.R. §§1.48(a) and (b). Pursuant to 37 C.F.R. §1.48(a) please add Martin Devenney, Eric McFarland, and Earl Danielson as joint inventors. Applicants note that these joint inventors were previously added to the parent application pursuant to 37 C.F.R. §1.48(a), but their declarations and statements were inadvertently omitted from the filing papers of the presently pending application. Copies of the Petition and the declarations and statements from the parent case are included with the Petition herein.

Application Number: 09/694,176

Docket: 98-15DIV1

All claims are in condition for allowance and Applicants therefore respectfully request a Notice of Allowance. Any questions concerning this application should be directed to the Applicants' representative at the number provided below.

Respectfully submitted,

Date:

Dec. 14, 2003

By:



Paul A. Stone, Reg. No. 38,628
Attorney for Applicants

Symyx Technologies, Inc.
3100 Central Expressway
Santa Clara, CA 95051
Phone: (408) 773-4027
Fax: (408) 773-4029